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ARLEN L. OLSEN SCHMEISER, OLSEN & WATTS 3 LEAR JET LANE SUITE 201 LATHAM, NY 12110			EXAMINER RIMELL, SAMUEL G	
			ART UNIT 2164	PAPER NUMBER
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/584,610
Filing Date: May 31, 2000
Appellant(s): NERENBERG ET AL.

Jack P. Friedman
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 1, 2004 appealing from the Office
action mailed January 28, 2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The Grounds of Rejection are Items 1-2 listed in appellant's brief on page 4. Item 3 on page 4 of the brief is not a separate grounds of rejection, but rather one of the issues associated with Item 1.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

(1) Publication Entitled "Death Visualization Therapy, Bringing to Life the Cherishing of Constructive Feelings and Action" by Arnold P. Nerenberg, hereafter referred to as "Death Visualization Therapy". (Available on E-Dan system as NPL dated 4/30/2003, 34 pages).

(2) U.S. Copyright Office Record indicating copyright date and publication date of Death Visualization Therapy by Arnold P. Nerenberg. (Available on E-Dan as NPL dated 4/30/2003, 2 pages).

(3) U.S. Copyright Office Instructions pertaining to publication date listed on Copyright Application. (Available on E-Dan as NPL dated 4/30/2003, 4 pages).

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-8, 12-17 and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Death Visualization Therapy, by Arnold P. Nerenberg.

Publication Date of the Reference: The reference to Death Visualization Therapy is a booklet published by the inventor of record of the present application. A U.S. Copyright Office

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record of a copyright application for this same booklet lists a copyright registration date of December 27, 1999, and a date of first publication as “Month: 3 Day: 20 Year: 1999” (March 20, 1999). According to a Copyright Office Instructions form, the Copyright statute defines “publication” as “the distribution of copies or phonorecords of a work to the public by sale or other transfer of ownership, or by rental lease or lending”. Since the publication date of March 20, 1999 is more than one year prior to the effective filing date of the present application (May 31, 2000) and meets the requirement of being “described in a printed publication” under 35 USC 102(b), the reference to Death Visualization Therapy is considered applicable as prior art under 35 USC 102(b).

Claim 1: Page 8 describes the provision of a coffin in a closed room for the purposes of conducting a psychological therapeutic method. As described on page 19, a first person (Joe’s Mother) and a second person (Joe) are brought into the room. The second person (Joe) is directed to lay in the coffin. The first person (Joe’s mother) can see the second person (Joe) in the coffin and is directed to speak to the second person (Joe) in regards to their personal relationship. Neither the first person nor the second person are rehearsing or acting in a theatrical performance.

Claim 4: The first person (Joe’s Mother) speaks to the second person (Joe) in regards to an emotion (page 19, lines 12-15).

Claim 5: The steps are performed by a facilitator (page 9, lines 9-13 and page 19, lines 8-13).

Claim 6: The facilitator is a professional therapist. In all descriptions in the booklet, the facilitator is Arnold P. Nerenberg, PhD.

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Claim 7: The coffin includes a visible pillow (page 8, line 3).

Claim 8: The lower portion of the coffin on the top side is covered or closed (page 8, line 5).

Claim 12: The first person (Joe's mother) is instructed to speak to the second person (Joe) in regards to specific feelings (page 19, lines 14-15).

Claim 13: Both the first person (Joe's Mother) and the second person (Joe) are questioned after the completion of the session (page 20, line 21: page 15, lines 19-27).

Claim 14: When the first person (Joe's Mother) is directed to speak to the second person (Joe), the first person (Joe's Mother) is speaking to Joe as if he had died and is laying in a coffin, which would be a moment of despair. The destructive habit can be drug abuse or road rage, as illustrated on page 28. The recitation that the first person actually has the destructive habit carries no patentable weight. The psychological characteristics of the person performing the method does not limit the method steps. The claim is limited by the steps themselves, not the personal characteristics of the person performing the steps.

Claim 15: The coffin used in the method serves as a trigger to induce specific thoughts leading to specific behaviors.

Claim 16: The first person (Joe's Mother) and the second person (Joe) are directed to make pledges (page 23, lines 11-12: page 17, lines 1-4: page 17, lines 13-19: page 28, line 7).

Claim 17: The destructive habit primarily described in the Death Visualization Therapy booklet is parental disrespect (page 4, lines 3-4), but other behaviors such as drug use and road rage are discussed in the booklet (page 28, lines 18-20).

Claim 19: See remarks for claim 1. Prior to implementation of the method, both the first person (Joe's Mother) and the second person (Joe) are questioned (Page 6, entire page). The questioning may also take the form of obtaining parental consent (page 28, lines 10-15).

Claim 20: See remarks for claim 4.

Claim 21: See remarks for claim 13.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Death Visualization Therapy, by Arnold P. Nerenberg, PhD in view of Official Notice.

Claims 9-10: Claims 9-10 differ from the Death Visualization Therapy Booklet in that the booklet does not specifically recite the presence of audio or video devices.

Examiner takes Official Notice that the usage of audio or video devices to record the statements of or behavior of individuals is very well known in psychology, experimental psychology, psychotherapy and interviews.

It would have been obvious to one of ordinary skill in the art to modify the Death Visualization Therapy Method in order to include recording devices so as to permit accurate recording and playback of the patient's behavior, as is well known in the art.

(10) Response to Argument

Appellant's Brief on page 5 includes a table indicating grouping of the claims, which is acceptable. However, examiner will address all the claims individually. Appellant refers to the

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Death Visualization Therapy Booklet using the shorthand notation “DVT”, which is also acceptable and will be adopted hereafter.

Claim 1: Argument is made that the DVT booklet allegedly does not disclose making the coffin visually available to the first person. In other words, the coffin is not disclosed as being visually available to Joe’s mother. This argument is not correct. Page 19 of DVT describes the scenario where the second person (Joe) is in the coffin and the first person (Joe’s mother) speaks to him. In order to speak to him, she would have to communicate to him while he was in the coffin, requiring that she see the coffin. There is no suggestion that the Joe’s mother speak to him from a distant location, through an opaque partition, through a wall in an adjacent room or via telephone, as appellant suggests. There is no statement in the booklet that such indirect conversation occurs. The conversation on page 19 can only occur as described by direct communication with Joe while he is laying in the coffin.

Argument is also made that in the DVT booklet, the first person is not directed to see the second person in the coffin. This argument is not correct. If the first person (Joe’s Mother) is directed to talk to the second person (Joe) while he is laying in a coffin, then she will necessarily see Joe in the coffin. There is no suggestion that the first person (Joe’s Mother) be directed to look away, or otherwise isolate herself from the second person (Joe) while conversing with him. In order to communicate with Joe, she will necessarily see Joe as he is laying in the coffin.

Claim 4: Claim 4 is grouped with claim 1. No specific arguments are presented.

Claim 5: Argument is made that the directing and instructing steps are not performed by a facilitator. This argument is not correct for several reasons. First, both pages 9 and 19 discuss the instructive actions of the facilitator. Secondly, if there was no facilitator, there is no

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suggestion that Joe and his mother would have gone out on their own initiative and obtained a coffin or related theatrical devices and practiced the claimed method steps on their own. The facilitator provides both the equipment and the instruction necessary to perform the claimed method and there is no suggestion in the DVT booklet that the steps are practiced without the facilitator being present.

Claim 6: Claim 6 is grouped with claim 1. No specific arguments are presented.

Claim 7: Argument is made that the pillow is not visually available to the first person. In the DVT booklet, the first person is Joe's mother. The DVT booklet states at page 8, line 3 that the coffin has a pillow. Accordingly, when Joe lays in the coffin (page 19), and his mother talks to him (page 19), it stands to reason that she will see both Joe and the coffin he is laying in, as well as anything associated with the coffin.

Claim 8: Claim 8 is grouped with claim 7. No specific arguments are presented.

Claim 12: Claim 12 is grouped with claim 1. No specific arguments are presented.

Claim 13: Argument is made that there is no teaching that the first person is questioned. This argument is not correct. In the DVT reference, the first person is Joe's Mother. Page 15, lines 19-27 set forth a question directed to Joe's Mother. The question requires a pre-determined response, in particular, a response relating to how she feels, such as good, neutral or bad. It cannot be just any response on any topic. The response is limited to certain specific information that can be pre-determined.

Claim 14: Argument is made that in the DVT reference, the moment of despair is not made in relation to a destructive habit. This argument is not correct. The DVT reference discloses a simulation of death as causing a moment of despair, the moment of despair being the

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action of talking to someone in a coffin (page 19) or weeping (page 19). This is suggested as a treatment for conflicts between parents and children, but also as treatments for drug abuse and road rage (page 28, last three lines) which are destructive habits.

Claim 15: Argument is made that the “power thought” of the DVT reference does not call for the envisioning of a destructive habit as causing adverse consequences. This argument is considered moot because the claim does not define the nature of the “power thought”. Additionally, it is highly questionable as to whether a person’s thoughts actually limit the content of claimed method step, since the thought itself does not constitute a method step or an action being taken. Even if the “power thought” were given its full meaning as ascribed by appellant, it is taught on page 19, where the first person (Joe’s mother) is described as weeping as a result of seeing Joe in a coffin (associating Joe’s behavior with death).

Claim 16: Argument is made that pledges are not discussed at pages 17, 23 or 28 of the DVT booklet. This argument is not correct. Pages 17 and 23 describe the pledge being made by the second person (Joe). Page 28 describes a pledge applicable to either Joe (second person) or Joe’s Mother (first person) and thoughts about the consequences of what will occur.

Claim 17: Argument is made that the first person (Joe’s mother) does not have destructive habits, and thus does not fit the scenario required for claims 14 and 17. This is not correct. Claim 14 calls for the first person (Joe’s Mother) to be at a moment of despair in relation to a destructive habit. The action of talking to someone in a coffin (page 19) and weeping (page 19) would logically be actions of despair. What the despair is about would require an analysis of her internal thought processes, which carry no patentable weight. What a person is thinking is not a method step and is not considered to be limiting of a claim addressed to a method step. If

alternatively, it were ascribed patentable weight, the feature is taught at page 28 of DVT. The despair can be caused by road rage or drug usage, both of which are destructive habits that can afflict either the first person or second person.

Claim 19: Argument is presented that the step of questioning the first person with questions have pre-determined fixed responses is not taught by the DVT booklet. This argument is not correct. Page 6 of the DVT booklet describes pre-testing of the subject prior to administering the coffin visualization steps. The questions being asked have pre-determined responses. For example, the therapist asks of the first person (Joe's Mother): "Is that Correct?" Pre-determined responses would be "Yes" or "No" or "I would" or "I would not".

Argument is also presented that the reference does not teach the concept of conditionally performing the coffin visualization steps in response to the questions. This is not correct. The entire purpose of the questions is to determine whether to initiate the method. If Joe were to state that he had no animosity towards his mother, there would be no logical reason to proceed. Page 28, lines 10-15 further provides additional disclosure that questioning to obtain parental (first person) consent is sometimes required, in which case the parental consent becomes the condition to proceeding with the method.

Claim 20: Claim 20 is grouped with claim 19. No specific arguments are presented.

Claim 21: Arguments are presented parallel to those of claim 13. Reference is made to the discussion of claim 13.

Claims 9-10 (Rejected under 35 USC 103): Argument is presented that the rejection lacks a teaching of motivation to apply the Official Notice to the DVT reference. This is not correct. The final rejection recites the motivation of providing accurate recording and playback

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of the patient's behaviour. This motivation would have been well understood by the person of ordinary skill in the art using recording equipment.

Additional Discussion on Applicability of DVT reference:

Additional argument is presented which disputes the applicability of the DVT reference under 35 USC 102(b). Argument is presented that that the DVT reference was not publicly available until after December 22, 1999, and was not publicly available on March 20, 1999.

The conclusion that the DVT reference is applicable as prior art under 35 USC 102(b) is based on several fundamental reasons:

(1) Appellant's copyright registration for this same booklet clearly indicates a first publication on March 20, 1999, and copyright statute indicates that such publication is a distribution to the public.

(2) Appellant's signature on the copyright registration verifies that the statements made in the copyright registration were correct.

(3) Appellant has submitted a declaration under 37 CFR 1.132 (Declaration of October 31, 2003) which claims that only a single copy was printed and such copy was not distributed. However, there is no factual evidence to support this allegation. Appellant has submitted invoice dated December 20, 1999 which requests publication of the booklet, but this invoice does not explain what happened to the publication or publications of March 20, 1999 referred to in the copyright application.

(4) The examiner cannot assume that the statements made by appellant in the copyright record were incorrect when appellant certified that they were correct and no evidence to the contrary has been presented.

Argument has been presented that examiner did not consider appellant's submission of rule 1.132 affidavits prior to the final rejection. This argument is not correct.

Appellant submitted a first declaration prior to the non-final office action of April 30, 2003. Appellant submitted a second declaration of October 31, 2003, prior to the final rejection, which included all the points of information raised in the first declaration and two additional points of information. Thus the declaration of October 31, 2003 is a complete compilation of all of appellant's declared statements.

Both the non-final and final office actions fully addressed each declaration in the "Remarks" section of the action. Points (3) and (4) mentioned on the previous page of this answer are a summary of the examiner's stated findings that were recited in the final office action. Appellant's declared statements have been fully addressed. I

It is imperative to note that an examiner's decision that a declaration is ineffective is not the same as a non-consideration of the declaration. The decision by the examiner that the declared statements were not effective in overcoming a rejection does not mean that these statements were not considered at all. Instead, it means that they were considered and found ineffective

A case law citation has also been presented by appellant, *Ex Parte Research and Mfg. Co.*, 10 USPQ 2d 1657 (Bd. Pat. App. & Interferences, March 9, 1989). The case pertains to a scenario in which date of publication listed in a Copyright Registration "A90038" was rebutted by factual evidence. However, in this case, the copyright registrations were rebutted by letters written by a third party participants ("Mr. Clutter", "Dr. Christensen" and "Mr. Baronowski"). No such third party information appears in this application. In addition, this case involved a

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scenario where the evidence demonstrated that the document in question was never even published. In the present case, applicant admits to publishing at least one booklet more than one year prior to the effective filing date.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Sam Rimell
Primary Examiner
Art Unit 2164

APPEAL CONFERENCE
OCTOBER 26, 2005

Conferees:

SAM RIMELL, PRIMARY EXAMINER
CHARLES RONES, SPE
JEAN HOMERE, SPE



CHARLES RONES
SUPERVISORY PATENT EXAMINER

